IN THE

Supreme Court of the United States

OCTOBER TERM, 1921.

Original No. 26

HARLEY-DAVIDSON MOTOR COMPANY AND ALEXANDER KLEIN,
Petitioners,

vs.

THE HONORABLES JOSEPH BUFFINGTON, VICTOR B. WOOLLEY AND J. WARREN DAVIS, UNITED STATES CIRCUIT JUDGES, AND THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

MOTION FOR LEAVE TO FILE PETITION FOR MANDAMUS.

MELVILLE CHURCH,
WILLIAM S. HODGES,
EDWIN B. H. TOWER, JR.,
Counsel for Petitioners.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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THE HONORABLES JOSEPH BUFFINGTON, VICTOR B. WOOLLEY AND J. WARREN DAVIS, UNITED STATES CIRCUIT JUDGES, AND THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

MOTION FOR LEAVE TO FILE PETITION FOR MANDAMUS.

And now come the above-named HARLEY-DAVIDSON MOTOR COMPANY and ALEXANDER KLEIN, by Melville Church and Edwin B. H. Tower, Jr., their counsel, and move for leave to file their annexed petition for a writ of mandamus, and that an order to show cause may be issued out of this Honorable Court, directed to the Honorables Joseph Buffington, Victor B. Woolley and J. Warren Davis, United States Circuit Judges, and to The United States Circuit Court of Appeals for the Third Circuit, requiring them to show cause why the writ of mandamus prayed for in said petition should not be granted.

HARLEY-DAVIDSON MOTOR COMPANY and
ALEXANDER KLEIN,
By

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.....

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Their Counsel.

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1921.

Original No. ——.

IN THE MATTER OF THE PETITION OF HARLEY-DAVIDSON MOTOR COMPANY AND ALEXANDER KLEIN, FOR A WRIT OF MANDAMUS DIRECTED TO THE HONORABLES JOSEPH BUFFINGTON, VICTOR B. WOOLLEY AND J. WARREN DAVIS, UNITED STATES CIRCUIT JUDGES, AND TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, HARLEY-DAVIDSON MOTOR COMPANY and ALEXANDER KLEIN, respectfully represent as follows:

I. That your petitioner, Harley-Davidson Motor Company, is a corporation created and existing under and by virtue of the laws of the State of Wisconsin, and has its principal place of business in Milwaukee, Wisconsin; and that the petitioner, Alexander Klein, is a resident of Philadelphia, in the State of Pennsyl-

vania, and was at the time of the institution of the suit hereinafter mentioned, an agent of the Harley-Davidson Motor Company, his co-petitioner.

II. That in a suit in equity for the infringement of certain letters patent relating to Clutches for Motor Cycles, brought in the United States District Court for the Eastern District of Pennsylvania, by Eclipse Machine Company and Frederick E. Ellett, plaintiffs, against your petitioners, as defendants, a decree was entered by the District Court, on the 7th day of September, 1917, dismissing the plaintiffs' bill of complaint on its merits. (244 Fed. 463.)

III. That, thereafter, on appeal duly taken by the plaintiffs in such cause to the United States Circuit Court of Appeals, for the Third Circuit, said last mentioned court reversed the decree of the District Court and directed that the bill of complaint be reinstated and that further proceedings be had in conformity to the opinion of the court (252 Fed. 805).

IV. That on or about the 18th day of December, 1918, the District Court, pursuant to the mandate of the Circuit Court of Appeals, entered an interlocutory order or decree adjudging claims 1, 8, 11 and 12 of letters patent No. 1,018,890 and claim 1 of letters patent No. 1,071,992, to be valid and to have been infringed by your petitioners; granting an injunction against your petitioners as to said claims; and referring the cause to a Master to take and state an account, the terms of said reference being as follows:

> "5. That the plaintiffs do recover from the defendants such profits, gains and advantages which

the said defendants have received or made or which have arisen or accrued to them or either of them, from the manufacture, use and sale of clutches containing any of the inventions or improvements set forth and claimed in claims 1, 8, 11 and 12 of said Letters Patent, No. 1,018,890, or any of said claims, or in claim 1 of said Letters Patent No. 1,071,992, and, such damages as the plaintiffs have sustained by reason of the infringement of said letters patent, or any of said claims thereof, by the defendants or either of them, to which the said plaintiffs may be found lawfully entitled when the sum thereof is found, as herein prescribed.

6. That this cause be referred to J. Washington Logue, Esq., who, by reason of his special qualifications is hereby appointed a Master of this Court, *pro hac vice,* to ascertain and take and state and report to the Court an account of the number of clutches containing and embodying any of the inventions or improvements contained in claims 1, 8, 11 and 12 of patent No. 1,018,890 and claim 1 of patent No. 1,071,992, or any of said claims, made or used or sold by the defendants, or either of them, and also all gains and profits and advantages which said defendants, or either of them have received or which have arison or accrued to them, or either of them, therefrom as aforesaid, and the damages which the complainants have sustained by reason of said infringement by said defendants."

V. That subsequently in the course of the proceedings before the Master your petitioners insisted that the Master should confine his findings to a certain type of clutch known and designated as the Slipping Clutch Exhibit G that was before the Circuit Court of Appeals on the appeal in the case, and should *exclude*

from consideration certain other types of clutches known and designated as Exhibits H, 179-14, 142-15, and 142-19, all said last mentioned clutches being as your petitioners are advised and believed non-infringing clutches and without the ambit of the claims of said patents, Nos. 1,018,890 and 1,071,992, as interpreted by the Circuit Court of Appeals, and one of said types of clutch, to wit, the type represented by Exhibit 142-19, being a type of clutch devised after and in view of the said decision of the Circuit Court of Appeals, and which type of clutch is now being largely manufactured and marketed by your petitioners, and in fact constitues its principal present output; but that the Master overruled your petitioners' contention and ordered that the accounting proceed as to clutches like said Exhibit H, 179-14, 142-15, and 142-19, in addition to clutches like Exihibit G.

VI. That the plaintiffs in said cause, instead of undertaking to test the infringing or non-infringing character of the said clutches Exhibits H, 179-14, 142-15 and 142-19 (1) by bringing on a proceeding for comtempt, or (2) by the filing of a new original bill of complaint against your petitioners, as they well might have done, elected to hold the Master's ruling as to said clutches *in terrorum* over your petitioners, to the great damage and detriment of your petitioners' business, whereupon your petitioners filed a petition in the District Court asking that Court to direct the Master to exclude from the accounting clutches like the said Exhibits H, 179-14, 142-15 and 142-19; but the District Court denied the said petition, and on the 7th day of October, 1921, entered an order embodying said denial, reading as follows:

"ORDER DENYING DEFENDANTS' PETITION.

Accounting proceedings having been had before the Master appointed by this Court by the interlocutory decree entered herein on December 18, 1918, and the said Master having rendered a decision to the effect that the clutches shown in Exhibits H, 179-14, 142-15, and 142-19 come under the two patents in suit found infringed and the interlocutory decree entered December 18, 1918, and having made an order directing the defendants to render and account upon said clutches and the defendants having petitioned this Court to direct the Master to restrict the accounting to the slipping clutch Exhibit G and exclude therefrom the clutches shown in Exhibits H, 179-14, 142-15 and 142-19 and having submitted to the Court in support of said petition the Court record and the record of the proceeding heretofore had before the Master, together with four affidavits of Edwin W. Hammer, two affidavits of Arthur G. Chapple, three affidavits of Arthur R. Constantine, two affidavits of Eugene C. Kicherer, and affidavits of Harold West, Edward R. Hughes, John F. McLoughlin, Bert E. Heinz, Stephen F. Briggs, Frank W. Schwinn and John E. Merz, and the plaintiffs having filed with the Court in opposition to said petition three affidavits of Frederick S. Ellett, two affidavits of John C. Ferguson, and affidavits of Robert W. Byerly, Joseph F. Merkel, William J. Brazenor, C. L. Waters, John U. Constant, Calvin R. Webber, Michael Skalka, Jesse H. Cooke, Charles Burdus, John Van Cise and Charles Bailey Franklin, and counsel for both parties having appeared before the Court.

It is Ordered under the opinion upon the petition:

1. That said petition be, and hereby is, denied.
2. That the decision of the Master holding the

clutches shown in Exhibits H, 179-14, 142-15, and 142-19 to be within the said patents and interlocutory decree and the order of the Master directing the defendants to account as to the said clutches be, and the same hereby are, confirmed.

By THE COURT,
DICKINSON,
District Judge."

VII. That thereupon the plaintiffs on the 7th day of October, 1921, made and submitted to the District Court a motion that your petitioners be specifically enjoyed from manufacturing, using or selling clutches like those shown in said Exhibits H, 179-14, 142-15 and 142-19, said motion reading as follows:

"And now comes the plaintiffs and move this Honorable Court to enter herein an order that the words 'any clutch or clutches containing or embodying the invention claimed in claims 1, 8, 11 and 12 of Letters Patent No. 1,018,890 or any of them, or in claim 1 of Letters Patent No. 1,071,992' in the interlocutory decree entered herein on December 18, 1918, include the clutches shown in Exhibits H, 179-14, 142-15 and 142-19 and that the defendants be specifically enjoined from manufacturing, using or selling the clutches shown in said exhibits.

In support of this motion the plaintiffs present to the Court the order entered herein this day denying the defendants' petition to direct the Master to restrict the accounting to the slipping clutch Exhibit G and exclude therefrom the clutches shown in Exhibits H, 179-14, 142-15 and 142-19 and also the entire record which was before the Court upon said petition.

ARCHIBALD COX,
R. W. BYERLY,
Counsel for Plaintiffs.

October 7, 1921."

VIII. That on the said 7th day of October, 1921, the District Court, the Honorable Oliver B. Dickinson, District Judge, sitting, entered an interlocutory order or decree granting the injunction prayed for by the plaintiffs; allowing an appeal from said order; and suspending the injunction pending the determination of such appeal, said order or decree reading as follows:

"ORDER GRANTING PLAINTIFFS' MOTION AND ALLOWING APPEAL.

The plaintiffs having moved the Court to enter herein an order that the words 'any clutch or clutches containing or embodying the inventions claimed in claims 1, 8, 11 and 12 of Letters Patent No. 1,018,890 or any of them, or in claim 1 of Letters Patent No. 1,071,992' in the interlocutory decree entered herein December 18, 1918, include the clutches shown in Exhibits H, 179-14, 142-15 and 142-19 and that the defendants be specifically enjoined from manufacturing, using or selling the clutches shown in said exhibits, and the issues raised by said motion being the same as these decided by this Court in its order entered this day, denying the defendants' petition to direct the Master to restrict the accounting to the slipping clutch Exhibit G and to exclude therefrom the clutches shown in Exhibits H, 179-14, 142-15 and 142-19.

It is Ordered:

1. That the words 'any clutch or clutches containing or embodying the inventions claimed in claims 1, 8, 11 and 12 of Letters Patent No. 1,018,890 or any of them, or in claim 1 of Letters Patent No. 1,071,992' in paragraph 4 of the interlocutory decree entered herein on December 18, 1918, include the clutches shown in Exhibits H, 179-14, 142-15 and 142-19.

2. That the defendants, Alexander Klein and the Harley-Davidson Motor Company, and each of them, their and each of their clerks, attorneys, agents, servants and workmen and all claiming or holding through or under them or either of them, be, and they hereby are, ordered to desist and refrain from making, selling or using, or in any manner whatsoever disposing of any clutch or clutches of the construction shown in Exhibits H, 179-14, 142-15 and 142-19, or any other clutch or clutches containing or embodying the inventions claimed in claims 1, 8, 11 and 12 of Letters Patent No. 1,018,890 or any of them, or in claim 1 of Letters Patent No. 1,071,992, and from infringing any of said claims of either of said Letters Patent, provided that this order shall not operate or be so construed as to operate to prohibit, prevent, or in any wise interfere with the supplying by the defendants, or any of them, of motor cycles, clutches or other parts thereof to the United States or any department or officer thereof under contract between the United States and said defendants, or any of them, or otherwise.

3. That the defendants having applied in open Court for an appeal, the same is hereby granted and allowed, conditioned upon the defendants giving the usual cost bond.

4. That the defendants having been allowed an appeal from this order and decree, the issuance of the injunction as to clutches H, 179-14, 142-15 and 142-19 is hereby suspended pending the determination of such appeal.

By The Court,
Dickinson,
District Judge."

IX. That your petitioners, on the 17th day of October, 1921, duly perfected their said appeal to the United States Circuit Court of Appeals for the Third Circuit by the filing of their assignment of errors, bond on appeal, etc., and the appeal came on to be heard in the United States Circuit Court of Appeals for the Third Circuit, the Honorables Joseph Buffington, Victor B. Wooley and J. Warren Davis, Circuit Judges, sitting, and on the 30th day of January, 1922, the said Court *dismissed* your petitioners said appeal without passing upon the merits thereof, accompanying said dismissal with a *per curiam* opinion reading as follows:

"PER CURIAM

The inventions of the patents in suit relate to clutches for motorcycles. On an opinion reported in 252 Fed. 805 this court held certain claims of two patents valid and infringed.

After the mandate had gone down, the District Court entered an interlocutory decree, enjoining in general terms all infringements of the claims specified, and referred the case to a master for an accounting. Thereafter the defendants made and used clutches of a new design which they claim are outside the scope of the decree. Accordingly, the moved the master to exclude them from the accounting. The master denied the motion. The defendants then petitioned the District Court for an order on the master to the same end. Recognizing that a decision in the matter called for a construction of the decree of this court on appeal, the District Court confirmed the master's ruling by entering an order denying the defendants' petition. The plaintiffs then appeared, and, taking a position opposite that of the defendants, moved the court for a construction of its inter-

locutory decree that would include as infringements the defendants' later clutches, and for a 'specific' injunction—in effect a supplementary injunction—against their use. The court entered the order and awarded the injunction prayed for. Thereupon the defendants brought this appeal. By these several moves the parties obtained what evidently both desired.

Without expressing an opinion upon the scope of the order as affecting infringement, we are quite certain that the order was made and the additional injunction awarded under a misconception of the practice prevailing in this circuit with regard to alleged infringements after decree.

The purpose of both proceedings below, the one instituted by the defendants and the other by the plaintiffs, was to try out in the courts, during the progress of the accounting, a question of after-infringement. To do this with certainty an interpretation of the scope of the appellate court's decree was considered necessary. Such interpretation, it was thought, could best be given by the court that made the decree, hence this proceeding for what we may call an advisory review on an interlocutory appeal.

The procedure by which the opinion of this Court as to the scope of its decree is sought for the guidance of the master in determining the scope of an accounting still in progress is, in its essentials, the same as the procedure instituted by the plaintiff in Minerals Separation Limited vs. Miami Copper Company, 268 Fed. 862, praying the Circuit Court of Appeals to hold that certain practices after the interlocutory decree were infringements within its interpretation of the patent claims. The court found this proceeding was not within the practice of this circuit, 269 Fed. 265. This court, at its present term, adhered strictly to that decision, when, on the reverse of the situation, the defendant in Minerals Separation Limited vs.

Miami Copper Company sought its opinion as to the scope of its decree by petition for a writ of mandamus to be addressed to the district judge commanding him to instruct his master to exclude from the accounting certain post decree practices on the ground that they were no infringements. Although these proceedings were different in form they were alike in their purpose to have the court stop and pass in review upon every new process as it was put into practice during the accounting and determine immediately whether it was within or without the scope of its decree. The court dismissed the petition.

As we have not been persuaded to establish a practice never recognized in this circuit, we are constrained to dismiss this appeal, leaving the order in question wholly within the control of the district judge."

X. That the action of said Court in dismissing the said appeal, which was properly lodged and properly before it, your petitioners are advised and believe was and is in violation of Section 129 of the Judicial Code guaranteeing to your petitioners an appeal, as a matter of right, from the said interlocutory order of October 7, 1921, granting an injunction against your petitioners, and the right to a consideration and determination of the merits of said appeal by said Circuit Court of Appeals.

XI. Wherefore, your petitioners, being without other remedy in the premises, pray that writ of mandamus be issued out of this Honorable Court to the Honorables, the said Joseph Buffington, Victor B. Woolley and J. Warren Davis, Circuit Judges, and to the said the United States Circuit Court of Appeals for the Third

Circuit, commanding said judges and the said Court, and each of them, to entertain and determine your petitioners said appeal from said interlocutory order of the District Court of October 7, 1921, granting an injunction against your petitioners, and for such other and further relief in the premises as to this Court may seem appropriate and in conformity to law.

HARLEY-DAVIDSON MOTOR COMPANY,
By
....,
President.

....
....
....
Of Counsel for Petitioners.

State of Wisconsin, County of Milwaukee, ss.

WALTER DAVIDSON, being first duly sworn, deposes and says: I am president of the Harley-Davidson Motor Company, petitioner above named. The foregoing petition is true to my own knowledge, except as to the matters therein stated to be alleged upon information and belief, and as to those matters, I believe the same to be true.

....

Subscribed and sworn to before me this—— day of ——, 1922.

....
Notary Public.

MEMORANDUM.

Extended argument of this petition is unnecessary. Its pith and essence is that, pending an accounting, the District Court has, upon formal application, passed an interlocutory order granting an injunction against petitioners, restraining them from making, using or selling several types of clutches not named in the original order or decree of the District Court and some of which did not come into existence until after the Circuit Court of Appeals had acted upon the case, and upon which neither the Circuit Court of Appeals nor the District Court had before passed.

One of these clutches, *i.e.*, that exemplified by Exhibit 142-19, is the clutch now being extensively and almost exclusively marketed by petitioners in their large business. This clutch was specially devised by petitioners to avoid even the appearance of infringement of plaintiff's patents and petitioners have been advised that it is not an infringement of them.

It was the avowed object and purpose of Section 7 of the Evarts Act (26 Stat. at L., 826) now embodied in Sec. 129 of the Judicial Code, to afford a prompt review of all interlocutory orders or decrees of a District or Circuit Court granting an injunction, not as a matter of favor, but as a matter of absolute right.

The action of the Circuit Court of Appeals complained of in this case deprives petitioners of this right of review.

If the present order of the District Court stands it may be that the long, painful process of an accounting which will easily cover several years, may have to be gone through before there is the possibility of a review of the District Court's action; and, meantime,

the public will be deprived of a very useful appliance that petitioners are advised and believe is clear of plaintiffs' monopoly.

The Circuit Court of Appeals for the Third Circuit may have ideas as to the establishment of a practice respecting the disposition of alleged new infringements pending an accounting, but certainly, in pursuit of that plan, it may not disregard petitioners' statutory rights.

Petitioners' new clutch, Exhibit 142-19, has been specifically enjoined by the District Court—that is a stubborn fact; and, we submit, the Circuit Court of Appeals cannot, if it would, avoid its duty of entertaining and disposing of, on its merits, petitioners' statutory appeal from the District Court's action.

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Counsel for Petitioners.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1921.

Original No. 26.

HARLEY-DAVIDSON MOTOR COMPANY AND ALEXANDER KLEIN,
Petitioners,

vs.

THE HONORABLES JOSEPH BUFFINGTON, VICTOR B. WOOLLEY AND J. WARREN DAVIS, UNITED STATES CIRCUIT JUDGES, AND THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

MOTION FOR JUDGMENT AND BRIEF IN SUPPORT OF SAME.

MELVILLE CHURCH,
WM. S. HODGES,
EDWIN B. H. TOWER, JR.,
Counsel for Petitioners.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

IN THE

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Petitioners,

vs.

THE HONORABLES JOSEPH BUFFINGTON, VICTOR B. WOOLLEY AND J. WARREN DAVIS, UNITED STATES CIRCUIT JUDGES, AND THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

NOTICE.

To the Honorables Joseph Buffington, Victor B. Woolley and J. Warren Davis, United States Circuit Judges, and to the United States Circuit Court of Appeals for the Third Circuit:

Take notice that, on Monday, the 24th day of April 1922, at the opening of the Court on that day, or as soon thereafter as counsel may be heard, we shall submit, without oral argument, the accompanying motion for a peremptory writ of mandamus notwithstanding the return to the rule to show cause herein.

Service accepted for myself and The Circuit Court of Appeals, Third Circuit, this 20th day of April, 1922.
JOS. BUFFINGTON.

MELVILLE CHURCH,
WM. S. HODGES,
EDWIN B. H. TOWER, JR.,
Counsel for Petitioners.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1921.

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NOTICE.

To the Honorables Joseph Buffington, Victor B. Woolley and J. Warren Davis, United States Circuit Judges, and to the United States Circuit Court of Appeals for the Third Circuit:

Take notice that, on Monday, the 24th day of April, 1922, at the opening of the Court on that day, or as soon thereafter as counsel may be heard, we shall submit, without oral argument, the accompanying motion for a peremptory writ of mandamus notwithstanding the return to the rule to show cause herein.

Service accepted for myself
this 18th day of April, 1922.
VICTOR B. WOOLLEY,
Circuit Judge.

MELVILLE CHURCH,
WM. S. HODGES,
EDWIN B. H. TOWER, JR.,
Counsel for Petitioners.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1921.

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HARLEY-DAVIDSON MOTOR COMPANY AND ALEXANDER KLEIN,
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Service accepted for myself
this 20th day of April, 1922.
J. WARREN DAVIS.

MELVILLE CHURCH,
WM. S. HODGES,
EDWIN B. H. TOWER, JR.,
Counsel for Petitioners.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1921.

Original No. 26.

IN THE MATTER OF HARLEY-DAVIDSON MOTOR COMPANY AND ALEXANDER KLEIN, PETITIONERS FOR A WRIT OF MANDAMUS DIRECTED TO THE HONORABLES JOSEPH BUFFINGTON, VICTOR B. WOOLLEY AND J. WARREN DAVIS, UNITED STATES CIRCUIT JUDGES, AND TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

MOTION FOR JUDGMENT NOTWITHSTANDING THE RETURN TO THE RULE TO SHOW CAUSE.

And now come the Petitioners, by Melville Church, William S. Hodges and Edwin B. H. Tower, Jr., their counsel, and move the Court for a peremptory Writ of Mandamus against the respondents notwithstanding the return to the rule to show cause herein.

HARLEY-DAVIDSON MOTOR COMPANY, and
ALEXANDER KLEIN,

By

MELVILLE CHURCH,
WM. S. HODGES,
EDWIN B. H. TOWER, JR.,
Their Counsel.

MEMORANDUM IN SUPPORT OF PETITIONERS' MOTION FOR JUDGMENT.

I. Petitioners' capital grievance is that the Circuit Court of Appeals has refused to hear and determine, but, on the contrary, has dismissed its regularly prosecuted statutory appeal from the interlocutory order of the District Court of October 7, 1921, enjoining petitioners from making, using or selling the motorcycle clutch constituting its principal present output.

II. The District Court was right or wrong in awarding the injunction complained of. If right, its order should be affirmed; if wrong, such order should be reversed.

III. The proposition of the Court of Appeals "to dismiss the appeal, leaving the order in question wholly within the control of the District Judge," affords no adequate remedy. If the District Judge should set aside his order and dissolve the injunction, the plaintiffs might immediately prosecute an appeal from such a ruling. If, on the other hand, he should reaffirm the order, petitioners would have a right of appeal therefrom, as before.

By the death or resignation of the District Judge, the matter would be further complicated.

IV. The trouble in this case is not of petitioners' making. It started when plaintiffs undertook to submit the question of the alleged new infringement to the Master, who is without judicial function to decide such a question as this very Court of Appeals has re-

cently decided. (Franklin Brass Foundry Co. *et al.* v. Shapiro & Aronson, C. C. A. 3d Cir., Fed. , affirming 272 Fed. 176-177).

Plaintiffs could have promptly tried out the matter of the alleged new infringement (1) by an application to the Court for an attachment for contempt, or (2) by the filing of a new bill and moving for an interlocutory injunction pursuant thereto. It preferred, however, to bring the matter before the Master in order that the charge of new infringement might be held *in terrorem* over the petitioners during the whole course of the accounting, which might take years.

By finally adopting the course of applying to the Court for a supplemental injunction, and getting it, petitioners' right of appeal attached, as a matter of right.

V. Although the District Judge refers to his order as a *pro forma* order, it is clear that it is not wholly so. For instance he finds that petitioners had made three styles of clutches and classifies them, including:

> "3. Other styles of clutch, neither made nor sold until after the finding of infringement had been made"(Return, p. 7).

Again, he finds that "the defendants manufacture motorcycles in large numbers. It is embarrassing almost to the point of paralysis for them to conduct their business facing the uncertainty of what they have the right to do or not to do. The issue raised is as sharply defined as an issue well could be." (Return, p. 10.)

He first wrote an opinion denying an injunction (Return, p. 10) and then subsequently wrote another one *granting* the injunction (Return, p. 13). The or-

der actually entered follows the latter (Petition, p. 9).

Leaning first one way and then the other, the District Judge evidently felt that he would be paying more respect to the Court of Appeals by giving the plaintiffs the benefit of the doubt that lay in his mind as to scope of the Court of Appeals' opinion on the former appeal.

There was consideration and the exercise of judgment on the part of the District Judge. He determined to put the petitioners under injunction. His action was not, therefore, *pro forma*.

VI. The Curtis Case (228 U. S. 695) referred to in the return really constitutes a precedent for petitioners' action. There the decree entered by the District Court was strictly *pro forma*. The judgment of this Court was not pitched upon the character of the decree. It was the participation of the trial judge in the determination of the case as a member of the Court of Appeals that constituted the reversible error. The Court of Appeals, properly constituted, was directed to hear and determine the appeal from the District Court's order.

In the Curtis case the, so-called, *pro forma* decree entered by the District Court, dismissing the bill, restored the *status quo ante*. In the case at bar, the, so-called, *pro forma* order placed the petitioners under injunction in respect to a new matter and changed materially the *status quo ante*.

VII. The work imposed upon the various Courts of Appeals is very heavy. Especially is this true of the Court of Appeals for the Third Circuit. Still, each of these courts must hear and determine the business

regularly brought before it pursuant to Statute. It cannot escape its duty.

In Minerals Separation Limited v. Miami Copper Co., 269 Fed. 265, where eleven (or sixteen) new processes were attempted to be adjudicated after decree sustaining the validity of the patent (1) by contempt proceedings, and (2) by requesting leave to file a supplemental bill under which a motion for a new injunction could be made, the Court held that the trial judges' discretion in denying both forms of relief would not be disturbed. But it is clear that if the plaintiff in that case had filed a new bill and moved for an interlocutory injunction thereon against the practice by the defendant of such eleven (or sixteen) modified processes, both the District Court and the Court of Appeals would have been required to adjudicate thereon in case the parties affected exercised their statutory rights.

The action of both trial and appellate courts determined only that the plaintiff in that case had mistaken its remedies; not that it had not a remedy that would have been efficacious to bring the question of infringement of the whole eleven (or sixteen) processes before both Courts for determination.

VIII. That petitioners are under injunction is a stubborn fact. It should not be left optional with the District Judge or his successor to decide whether the order granting the injunction should stand or be set aside, as decided by the Court of Appeals.

MELVILLE CHURCH,
WM. S. HODGES,
EDWIN B. H. TOWER, JR.,
Counsel for Petitioners.

April 17, 1922.

EX PARTE IN THE MATTER OF HARLEY-DAVIDSON MOTOR COMPANY ET AL., PETITIONERS.

PETITION FOR A WRIT OF MANDAMUS.

No. 26, Original. Motion for judgment notwithstanding rule to show cause. Submitted April 24, 1922.—Decided June 5, 1922.

1. The granting by the District Court with the acquiescence of the parties of an order of interlocutory injunction, merely that it may be appealed to the Circuit Court of Appeals and the cause thus in effect be submitted to that court as though it were a court of original jurisdiction, is not a compliance with § 129, Jud. Code, which contemplates review after the District Court has itself heard and considered. P. 416.
2. An appeal in such case gives jurisdiction to the Circuit Court of Appeals; and, although that court may decline to consider the merits and may reverse and remand the cause for proper proceedings because of the *pro forma* character of the order appealed from, it cannot dismiss the appeal for that reason, and thus leave the interlocutory injunction in force. P. 418.

Mandamus issued.

MANDAMUS to require the Circuit Court of Appeals and its judges to entertain and determine an appeal from an order of the District Court granting an interlocutory injunction.

Mr. Melville Church, Mr. William S. Hodges and *Mr. Edwin B. H. Tower, Jr.*, for petitioners, in support of the motion.

MR. JUSTICE DAY delivered the opinion of the court.

Harley-Davidson Motor Company and Alexander Klein filed a petition for a writ of mandamus to the judges of the Circuit Court of Appeals for the Third Circuit. In substance it sets forth: That in a suit for infringement of letters patent relating to clutches for motorcycles, brought in the District Court of the United States for the Eastern

District of Pennsylvania by the Eclipse Machine Company and Frederick E. Ellett against the petitioners, a decree was entered by the District Court dismissing the plaintiffs' bill, 244 Fed. 463. Upon appeal to the United States Circuit Court of Appeals for the Third Circuit the decree of the District Court was reversed, 252 Fed. 805. The District Court pursuant to the mandate of the Circuit Court of Appeals entered an interlocutory decree adjudging claims 1, 8, 11 and 12 of letters patent No. 1,018,890, and claim 1 of letters patent No. 1,071,992 to be valid and infringed by the petitioners; and granted an injunction, with reference to a master to take and state an account. Subsequently, in the proceedings before the master, petitioners insisted that the master should exclude from consideration certain other types of clutches, which are described. The later types, it is averred, were devised after and in view of the decision of the Circuit Court of Appeals, and were being largely manufactured and sold by the petitioners. But the master overruled the petitioners' contention and ordered that the accounting proceed as to said types of clutches. The petitioners filed a petition in the District Court asking the court to direct the master to exclude from the accounting the clutches aforesaid, but the District Court denied the petition and confirmed the order of the master. Plaintiffs made and submitted a motion to the District Court asking that petitioners be enjoined from manufacturing, using or selling the types of clutches in controversy. The District Court entered an interlocutory order granting an injunction and allowing an appeal from the order to the Circuit Court of Appeals. Petitioners thereafter duly perfected their appeal to the Circuit Court of Appeals, consisting of the judges named in the present petition. That court dismissed the appeal without passing upon the merits thereof, although it was properly taken under § 129 of the Judicial Code. Petitioners prayed for the writ of

mandamus to the judges constituting the Circuit Court of Appeals, and to that court, commanding them and it to entertain and determine the appeal, and for such other relief as might seem appropriate and in conformity to law.

An order to show cause was issued, and a return made by the judges. The cause now comes on for hearing on motion for judgment for the petitioners notwithstanding the return.

The return sets forth that the order in the District Court granting the interlocutory injunction was entered *pro forma* as a means of propounding certain questions of infringement to the Circuit Court of Appeals which the District Court failed to pass upon. It recites the proceedings in the District Court in the attempt to exclude from the accounting the disputed types of clutches, and avers that in the course of the proceedings the District Court ruled that while ordinarily it would be its duty to determine the question raised as to whether or not the particular types were within the decree of infringement, it suggested that the plaintiffs move for an injunction restraining petitioners (then defendants) from making, using or vending the same, and that the District Court *pro forma* allow or deny the writ, that an appeal be promptly taken. A stipulation of counsel was filed in accordance with this suggestion. The District Court denied the motion to direct the course of accounting before the master, and allowed the interlocutory injunction *pro forma*. The return further sets forth that upon this record, supplemented by the frank statements of counsel to the same effect, the court declined to hear the appeal and dismissed it, leaving the order in question wholly within the control of the District Judge.

Section 129 of the Judicial Code provides:

"Where upon a hearing in equity in a district court, . . . an injunction shall be granted, . . . an appeal may be taken from such interlocutory order or decree granting . . . an injunction."

In a memorandum accompanying the return the judges of the Circuit Court of Appeals set forth that the order below having been made *pro forma*, without the exercise of judicial discretion by the District Court, did not present in any real sense an appealable order. The return further states that the order made was not in accord with the established practice in the Third Circuit. That the remedy to prevent the use of the clutches made after the decree, and claimed to have been in violation thereof, should have been sought by attachment for contempt, a proceeding for an accounting, or an original bill.

We have examined the record before us on this application, which includes the opinions of the District Court and the Circuit Court of Appeals. As this is an application for the writ of mandamus, we have no authority to review the judgment of the Circuit Court of Appeals such as we would have in cases brought before this court on appeal or writ of error. We accept, indeed there is little room to question, the conclusion and judgment of the Circuit Court of Appeals that the order of the District Court was made *pro forma* for the purpose of laying the foundation for an appeal to the Circuit Court of Appeals.

The Circuit Court of Appeals, upon abundant showing, found that the District Judge, not wishing to exercise an independent judgment upon the questions raised, made a *pro forma* order granting the injunction to the end that an appeal might be prosecuted. This was done with the acquiescence of counsel. We agree with the Circuit Court of Appeals that the effect of this method of procedure was to submit the cause to it as though it were a court of original jurisdiction, and to put upon it a labor of examination and consideration not imposed by the statute. The purpose of the statute is to enable the Circuit Court of Appeals to review the order of the District Court after that court has itself heard and considered the application. The practice of thus entering *pro forma* judgments or de-

crees has been disapproved by this court in *William Cramp & Sons Co.* v. *International Curtiss Marine Turbine Co.*, 228 U. S. 645. See also *United States* v. *Gleeson*, 124 U. S. 255.

We agree with the Circuit Court of Appeals that it was not required to consider the order, thus made by the District Court, as one properly before it on its merits. But the Circuit Court of Appeals had acquired jurisdiction by the appeal, and did not reverse the order of the District Court and remand the cause for proper proceedings, as it might have done. It dismissed the appeal. The effect of such dismissal was to leave the interlocutory injunction in full force. In this respect the Circuit Court of Appeals failed to exercise the jurisdiction conferred by law. The statute gave an appeal; the appellant had the right to have it decided. By the order of dismissal that right was denied.

We conclude that a writ of mandamus should issue requiring the Circuit Court of Appeals to decide the appeal presented. That course will leave it within its power to reverse and remand the cause to the District Court for further proceedings in accordance with law, because of the view it took of the record growing out of the *pro forma* character of the order appealed from.

Mandamus issued.